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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/668,039

09/21/2000

William J. Beyda

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9089

7590

05/16/2006

Siemens Corporation  
Intellectual Property Department  
186 Wood Avenue South  
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EXAMINER

REFAI, RAMSEY

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/668,039	Applicant(s) BEYDA, WILLIAM J.	
	Examiner Ramsey Refai	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 14-18 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 14-18 and 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

Responsive to Amendment received February 21, 2006. Previously withdrawn claims 6-13, and 19-28 have been canceled. Claims 1, 14, 29, and 31 have been amended. Claims 1-5, 14-18, and 29-33 remain pending further examination.

### *Specification*

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The limitations “human-readable” and “intrinsic human intelligible meaning” are not defined in the specification.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5, 14-18, and 29-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations “human-readable” and “intrinsic human intelligible meaning” are not described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-5, 14-18, and 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The claims include the terms “human-readable” and “intrinsic human intelligible meaning” which are not defined in the specification. Since the definitions of these terms are unclear, the use of these terms renders the claims vague and indefinite.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 14-18, and 29-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Fields et al (U.S. Patent No. 6,704,797).

7. As per claim 1, Fields et al teach an electronic messaging system for filtering electronic messages, comprising

a message server operable to receive and transmit electronic messages including electronic mail messages, the message server comprising an access restriction filter configured to detect an access restriction notice having a human-readable presentation comprising one or more human readable characters having an intrinsic human-intelligible meaning that access to information associated with the access restriction notice is restricted (column 2, lines 40-58, column 6, lines 52-54);

wherein the access restriction filter is configured to detect the access restriction notice in an electronic message, by comparing one or more characters of the access restriction notice to respective characters of one or more access restriction notices stored-in memory and to respond to the detection of the access restriction notice in accordance with a prescribed transmission policy for handling electronic messages containing the detected access restriction notice (column 2, line 35—column 3, line 15).

8. As per claim 2, Fields et al teach wherein the access restriction filter is configured to detect in the electronic message an access restriction notice indicating ownership of at least a portion of the electronic message (**column 2, lines 35-60**).
9. As per claim 3, Fields et al teach wherein the access restriction filter is configured to detect a copyright notice in the electronic message (**column 1, lines 35-41, column 6, lines 50-54**).
10. As per claim 4, Fields et al teach wherein the access restriction filter is configured to detect the copyright notice by comparing one or more characters in the electronic message to respective characters of one or more copyright notices stored in memory (**column 2, line 35—column 3, line 15**).
11. As per claim 5, Fields et al teach wherein the access restriction filter is configured to detect the copyright notice by comparing characters in header component of the electronic message with respective characters of the one or more stored copyright notices (**column 4, lines 44-67**).
12. As per claim 30, Fields et al teach wherein the access restriction filter is configured to detect at least one of the following notices in the electronic message: a "confidential" notice, an "internal use only" notice, an "attorney-client privileged" notice, and an "attorney work product" notice (**column 6, lines 50-54, column 7, lines 19-67**).
13. As per claim 33, Fields et al teach wherein the electronic message comprises a primary message and at least one attachment, and the access restriction filter is configured to compare characters in the primary message and characters in the at least one attachment to respective characters of the one or more stored access restriction notices (**column 4, lines 34-39**).
14. As per claims 14-18, 29, 31, and 32, these claims contain similar limitations as claims 1-5 and 30 above, therefore are rejected under the same rationale.

***Response to Arguments***

15. Applicant's arguments with respect to the Stebbings reference have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to the 112 first paragraph rejection and the objection to the specification have been fully considered but they are not persuasive. The Applicant is arguing that the 112 first paragraph rejection and the objection to the specification should be withdrawn. In response, the Applicant respectfully disagrees. The MPEP states that newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. The Applicant arguments have not convinced the Examiner that the specification meets the written description requirement. In the remarks, the Applicant has pointed to MPEP 2163.II.A 3(b) to provide support for the Applicant's position that "the specification need not contain a literal transcription of the claim language defining the invention in order to satisfy the written description requirement." However that MPEP citation states that "*When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.*" The claimed invention does not require the use of the term. The Applicant further argues that "[e]ven though the specification does not explicitly recite that the constituent characters of these exemplary access restriction notices are 'human readable', one skilled in the art certainly would have understood that each constituent characters is in fact human-readable". However, this statement is inaccurate. The methods of detecting an access restriction notice in the specification include "interrogating a *header component* of the electronic message", translating characters in an image component of the electronic message into *computer readable character representations* (page 2, Applicants specification), and also conventional character recognition technology may be used to translate the image data into *computer readable form such as ASCII codes* (page 3, Applicants specification). These methods teach away from the Applicants argument that "one skilled in the art certainly would have understood that each constituent characters is in fact *human-readable*" since the methods are directed to electronically detecting an access restriction by interrogating a header component and converting the electronic message into computer code. Therefore the access restriction notices can be

interpreted as *electronic* access restriction notices readable only to a computer and not human readable. Since the specification does not provide adequate support for the term "human-readable", the 112 first paragraph rejection and the objection to the specification are maintained.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

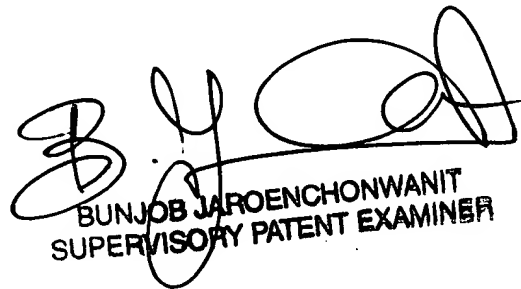
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai  
Examiner  
Art Unit 2152  
May 4, 2006



BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER